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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,265	08/28/2001	Han S. Cho	CS11122	7226
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MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			EXAMINER GENACK, MATTHEW W	
			ART UNIT 2645	PAPER NUMBER

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/941,265

Applicant(s)

CHO, HAN S.

Examiner

Matthew W. Genack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The declaration filed on 28 February 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Jang *et. al.* reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Jang *et. al.* reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

While the Motorola Patent Committee document discusses Applicant's conception of his invention, there is insufficient complete conception of all limitations of the current claims. Specifically, said document does not disclose Internet enabled mobile wireless communication devices, nor anything related to the Internet in general.

Applicant fails to establish diligence after consideration of the written invention disclosure and before preparation of the specification and drawings by or on behalf of attorney or patent agent. Diligence of patent preparation is stated in terms of a general allegation. This is especially the case since the critical period when diligence must be shown appears to be lengthy. Thus, the evidence submitted is insufficient to establish diligence from a date prior to the date of

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reduction to practice of the Jang *et. al.* reference to either a constructive reduction to practice or an actual reduction to practice.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 5, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Joglekar *et. al.*, U.S. Patent No. 5,535,258.

Regarding Claims 1 and 5, Joglekar *et. al.* discloses a radio telephone interface apparatus that allows a user to quickly dial stored telephone numbers (Abstract, Column 3 Lines 11-14). A single key is pushed a number of times corresponding to the directory location associated with the stored telephone number that the user wishes to call, and said telephone number is automatically dialed (Column 10 Lines 15-49, Figs. 3-8). It is inherent that the successive key inputs (and therefore the last key input) must be maintained for a certain time interval, for if a key is depressed for a short enough interval, the processor to which it is connected will not detect said key depression. This is the case

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because the switch associated with said key will not be actuated if said key is not depressed for a minimum time interval.

Regarding Claim 2, a stored directory telephone number is associated with sequential depressions of the same input key, as outlined in the rejection of Claim 1.

Regarding Claim 12, Joglekar *et. al.* discloses a radio telephone interface apparatus that allows a user to quickly dial stored telephone numbers (Abstract, Column 3 Lines 11-14). A single key is pushed a number of times corresponding to the directory location associated with the stored telephone number that the user wishes to call, and said telephone number is automatically dialed (Column 10 Lines 15-49, Figs. 3-8). It is inherent that the successive key inputs (and therefore the last key input) must be maintained for a certain time interval, for if a key is depressed for a short enough interval, the processor to which it is connected will not detect said key depression. The wireless telephone of the invention has a processor, memory, and a keypad with a plurality of keys (Fig. 8).

4. Claims 1-2, 5, 9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Jang *et. al.*, U.S. Patent Application Publication 2002/0091754.

Regarding Claims 1 and 5, Jang *et. al.* discloses a procedure whereby a connection code is entered on a wireless telephone terminal's keypad, said code being a shortcut for a telephone number, said telephone number being dialed when the last button is held for a minimum time ([0054], Figs. 3-4).

Regarding Claim 2, the combination of numbers in the code may be anything ([0055]), and thus a string of the same number is permissible.

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Regarding Claim 9, Jang *et. al.* discloses a method by which the user of an Internet-enabled cellular telephone can access a given URL (Abstract, Fig. 1). In order to access the site associated with the URL, the cellular telephone must transmit the URL. In particular, the depression of a particular key for longer than normal will load the website associated with the URL (which is stored in the telephone) that is associated with that particular key ([0057]).

Regarding Claim 12, Jang *et. al.* discloses a procedure whereby a connection code is entered on a wireless telephone terminal's keypad, said code being a shortcut for a telephone number, said telephone number being dialed when the last button is held for a minimum time ([0054], Figs. 3-4). The combination of numbers in the code may be anything ([0055]), and thus a string of the same number is permissible. The presences of a processor and memory are inherent to the wireless telephone of the invention.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4, 6-8, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.* in view of Tiilikainen, U.S. Patent No. 5,710,810.

Jang *et. al.* discloses every limitation of Claims 1, 5, and 12, upon which Claims 3-4, 6-8, and 13-17 depend, respectively, as outlined above.

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Jang *et. al.* does not expressly disclose the feature whereby at least two separate telephone numbers are associated with one name on the wireless telephone's calling list.

Tiilikainen discloses the feature whereby a given individual on the user's list may have more than one telephone number associated with him, in the context of quick dialing from a mobile telephone (Column 1 Line 62 to Column 2 Line 11).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Jang *et. al.* by combining the feature whereby a given individual on the user's list may have more than one telephone number associated with him, with the feature of the invention of Jang *et. al.* in which different numbers of depressions of one input key causes the retrieval of different telephone numbers from memory, with the combined result of depressing a certain key any of a given number of times is the retrieval of one of many telephone numbers associated with one individual.

One of ordinary skill in the art would have been motivated to make this modification because it would make it easier to memorize the key-individual correspondences, and because of the convenience of calling a given individual at any particular telephone number associated with that individual.

7. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.*

Jang *et. al.* discloses every limitation of Claim 9, upon which Claims 10-11 depend, as outlined above. However, the embodiment of Jang *et. al.* used in this

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rejection does not disclose the use of sequential depressions of the same input key. In another embodiment, Jang *et. al.* discloses that the combination of numbers in the code used for speed-dialing may be anything ([0055]), and thus a string of the same number is permissible.

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to combine these two embodiments of the invention of Jang *et. al.* so that sequential depressions of one key result in the Internet-enabled cellular telephone accessing the URL associated with said number of sequential depressions of said key.

One of ordinary skill in the art would have been motivated to combine these features because of the convenience offered to the user of being able to access a website with a small number of keystrokes, and because of the decreased probability of not reaching the website on the first attempt because of an accidental depression of the wrong key.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.* in view of Tiilikainen.

Further in view of the rejection of Claim 17, upon which Claim 18 depends, Jang *et. al.* discloses that the combination of numbers in the code may be anything ([0055]), and thus said code may consist of two adjacent integers in the range 0 to 9.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang *et. al.* in view of Tiilikainen, further in view of Mager, U.S. Patent Application Publication 2003/0017839.



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Jang *et. al.* in view of Tiilikainen discloses every limitation of Claim 13, upon which Claim 19 depends, as outlined above.

Neither Jang *et. al.* nor Tiilikainen discloses the use of a mobile wireless communication device that has email features.

Mager discloses a mobile electronic communication device that may store telephone numbers, email addresses, and URLs ([0027] Lines 1-3).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Jang *et. al.* as modified by Tiilikainen by using a wireless telephone that stores email addresses in addition to telephone numbers and URLs.

One of ordinary skill in the art would have been motivated to make this modification because of the increased flexibility offered to the user when he is able to store email addresses in his wireless telephone.

10. Claims 3-4, 6-8, and 13-17 are rejected under 35 U.S.C. 103(a) as being obvious over Joglekar *et. al.* in view of Tiilikainen.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference,

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prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The rejection of these Claims is parallel to that of Paragraph 6 of this Office Action, with instances of "*Jang et. al.*" being replaced by "*Joglekar et. al.*"

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being obvious over *Joglekar et. al.* in view of *Tiilikainen*, further in view of *Mager*.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The rejection of this Claim is parallel to that of Paragraph 9 of this Office Action, with instances of "*Jang et. al.*" being replaced by "*Joglekar et. al.*"

### ***Response to Arguments***

12. Applicant's arguments filed 30 September 2005, pertaining to diligence and conception, and the allowability of Claims 1, 5, and 12, have been fully considered but they are not persuasive.

Regarding Applicant's argument pertaining to diligence and conception, the lack of mention of anything pertaining to the Internet in Motorola Patent Committee document indicates a lack of conception of the claimed invention, regardless of the existence of other devices at the time of the invention that combined two or more features of the claimed invention (in this case, cellular telephones and the ability to access the Internet) because the conception of an invention entails the mental act of explicitly combining every critical element of said invention together in a specific way, or ways.

Regarding Applicant's argument pertaining to Claims 1, 5, and 12, Applicant concedes that "Maintaining requires depressing the key for longer than is required to actuate the switch. *Joglekar et. al.* discloses no more than actuating the switch." First, Applicant does not recite anything equivalent to the

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first quoted sentence in Claims 1, 5, and 12. Second it is correct that Joglekar *et. al.* teaches merely actuating the switch, however, the last key input must be maintained for a minimum time interval for transmission to occur, since the act of "maintaining" constitutes keeping a key in a depressed state. Therefore, the limitation in question is met by Joglekar *et. al.*

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 571-272-7541. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Matthew Genack

Examiner

Art Unit 2645

*Matthew Genack*

7 December 2005

*Fan Tsang*  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
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